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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,630	12/14/2001	William R. Matz	36968/265389	9447

7590 08/09/2004

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EXAMINER	
OUELLETTE, JONATHAN P	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/017,630	MATZ ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17,19 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17,19 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claim 18 has been cancelled; therefore, Claims 1-17, 19 and 20 remain pending in application 10/017630.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

3. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1, 3, 5, and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eldering et al. (US 6,457,010) in view of Klarfeld et al. (US 2003/0067554 A1).**

5. As per independent Claims 1, 12, and 16, Eldering discloses a method for providing a tailored media content (C1 L64-66) comprising: analyzing a subscriber attribute in a subscriber database; identifying unfulfilled subscriber demand based on said subscriber attribute and a media-content-access history of said subscriber (abstract, C1 L38-66, C4 L9-61, Fig.1, Fig.6).

6. Eldering fails to expressly disclose, in response to determining that an existing media-content offering does not meet subscriber demand, developing (and delivering) a new media-content offering from previously unavailable media-

content based on said subscriber attribute in combination with the media-content-access history of said subscriber.

7. However, Official notice is given that data-mining applications/techniques were well known at the time the invention was made, and identifying unfulfilled subscriber demand would be a simple matter of mining the viewer history data collected in the system disclosed by Eldering.
8. Furthermore, Klarfeld discloses developing targeted content (movies, shows, personal channel) based on television user viewing histories and user demographics (Abstract, Para 0087, Para 0258-0261).
9. Finally Klarfeld fails to expressly disclose wherein a subscriber attribute includes the purchasing history of said subscriber.
10. However, Eldering does disclose that purchasing histories were a well-known measure of user demographics (user attribute) at the time the invention was made (C1 L38-43).
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in response to determining that an existing media-content offering does not meet subscriber demand, developing (and delivering) a new media-content offering from previously unavailable media-content based on said subscriber attribute (purchasing history of said subscriber) in combination with the media-content-access history of said subscriber, as disclosed by Klarfeld in the system disclosed by Eldering, for the advantage of providing a method for providing a tailored media content, with the

ability to increase customer satisfaction by continually improving and updating offered media content based on user requirements/requests.

12. As per Claim 3, Eldering and *Klarfeld* disclose wherein said media-content-access history comprises a demographic measure (Fig. 23b) and wherein the method further comprises; pricing said new media-content offering; and delivering said new media-content offering to said subscriber (See rejection of Claims 8-10, 13, and 14).
13. As per Claim 5, Eldering and Klarfeld disclose wherein said step of identifying unfulfilled subscriber demand comprises analyzing an existing media-content offering
14. As per Claims 8-10, 13, and 14, Eldering and Klarfeld fail to expressly disclose the steps of setting a price for said new media-content offering based on a cost to develop said new media-content offering, developing a direct marketing campaign complementary to said existing media-content offering whereby subscribers are directed to the existing offering, and developing an incentive plan complementary to at least one of said existing media-content offering and said new media-content offering.
15. However, these steps are obvious business strategies/techniques commonly used at the time the invention was made.
16. Furthermore, these steps can be accomplished completely through the use of the common business training/knowledge and require no additional apparatus described in the specification, which would have made the steps non-obvious to combine with the method described by Eldering, in order to create a method for

providing a tailored media content, with the advantage of attracting customers using common business strategies/techniques.

17. As per Claims 11 and 15, Eldering and Klarfeld disclose creating a marketing bundle, wherein said marketing bundle comprises at least one of said existing media-content offering a product and said new media-content offering of a product and wherein the marketing bundle is created based on at least one of the following indirect methods of determining at least one of popularity of programming and effectiveness of advertising: focus group tests; post-advertising surveys; and measures of product purchases (See Rejection of Claims 8-10, 13, and 14).

18. **Claims 2, 4, 6, 7, 17, and 19-20 are rejected under 35 U.S.C. 103 as being unpatentable over Eldering in view of Klarfeld.**

19. As per Claims 2 and 17, neither Eldering nor Klarfeld expressly show wherein said attribute further comprises a purchase history of said subscriber.

20. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of attribute used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the purchase history of said subscriber

as an attribute in the method for providing a tailored media content, because such an attribute does not functionally relate to the steps in the method claimed and because the subjective interpretation of the attribute does not patentably distinguish the claimed invention.

22. As per Claims 4 and 19, neither Eldering nor Klarfeld expressly show wherein said media-content-access history comprises a subscriber content-choice database.

23. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content-access history used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

24. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a subscriber content-choice database as a media-content-access history in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content-access history does not patentably distinguish the claimed invention.

25. As per Claims 6, 7, and 20, neither Eldering nor Klarfeld expressly show wherein said step of delivering said new media-content offering comprises delivering a previously unavailable television program or delivering a previously unavailable television-programming package.

26. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method for providing a tailored media content would be performed regardless of the type of media-content offering used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a previously unavailable television program or a previously unavailable television-programming package as the media-content offering in the method for providing a tailored media content, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the media-content offering does not patentably distinguish the claimed invention.

Response to Arguments

28. Applicant's arguments with respect to claims 1-17, 19, and 20 have been considered but are moot in view of the new ground(s) of rejection.

29. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
August 3, 2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600